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THE MAXHAM FIRM
9330 SCRANTON ROAD, SUITE 350
SAN DIEGO CA 92121

MAILED

FEB 27 2009

OFFICE OF PETITIONS

In re Application of :
Brune, et al. :
Application No. 09/980,042 : DECISION
Filed/Deposited: 25 March, 2002 :
Attorney Docket No. 740-63 :

This is a decision on the petition filed on 10 July, 2008, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition under 37 C.F.R. §1.181 is **DISMISSED**.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181 to Withdraw the Holding of Abandonment."

Petitioner's alternative is to file a petition pursuant to 37 C.F.R. §1.137(b) with fee, reply and statement of unintentional delay, as discussed below.

As to the Request to Withdraw
the Holding of Abandonment

Petitioner is directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181.

Petitioner appears not to satisfy—or to be able to satisfy—the showing requirements set forth in the guidance in the Commentary at MPEP §711.03(c)(I).

For reference: Petitioner's attentions are directed to the guidance set forth in the Commentary at MPEP §711.03(c)(I)—and with particularity to the requirements therein including statements of non-receipt at the address of record, search and non-discovery, with a description of docketing system and a statement of its reliability, and support for those the statements with copies of the docket record/file jacket cover and due date calendar/docket. And the requirements of the regulations at 37 C.F.R. §1.181 further require that a Petitioner seek relief within two (2) months of the act complained of.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action (copy enclosed) mailed on 31 July, 2007, with reply due absent extension of time on or before 31 October, 2007.

The application went abandoned by operation of law after midnight 31 October, 2007.

The Office mailed the Notice of Abandonment on 8 April, 2008.

The record reflects that the U.S. Postal Service returned to the Office as undelivered both the 31 July, 2007, non-final Office action and the 8 April, 2008, Notice of Abandonment.

On 10 July, 2008, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.181 seeking withdrawal of the holding of abandonment and indicating the basis of his averment the non-receipt of the non-final Office action. Petitioner further avers that:

- In or about August 2006 he filed a notice with the U.S. Postal Service (USPS) to forward his mail from his former address to his new address (i.e., from: 750 B Street/Ste. 3100, San Diego CA 92121, to: 9330 Scranton Road/Ste. 350, San Diego, CA 92121);
- In July 2007 he tried to access the application in what he terms "PAIR" but what apparently meant to refer to "Private PAIR"—and states that he "first learned that [this application] was not entered in the system";
- However, he appears to acknowledge that he took no further action in this regard, and on 28 March, 2008 he was informed that the application was deemed have been abandoned—at which point he indicates that he asked "why this application has never been in the PAIR (sic) system and why *** someone didn't look at our most recent submission to get the correct address";
- On 1 April, 2008, he again asked Office personnel "why was this application not in the PAIR (sic) system and [advised the Office staff member] that we had duly filed an address change for our customer number,"

From the outset, Petitioner presents no evidence, makes no showing whatsoever that he took any action at all to associate his Customer Number (00616) with the instant application upon its filing, and the record reflects no such transaction until Petitioner's filing of a Notice of Change of Address on 10 July, 2008, by which Petitioner for the first time associated his Customer Number with the instant application—some eight and one-half months after the instant application went abandoned by operation of law.

Thus, the problem was not that the instant application “was not in PAIR (sic).” The problem was that Petitioner took no action in the first forty-four (44) months of the prosecution of the application to associate the application with his Customer Number and so gain access to the application online in Private PAIR.

Moreover, Petitioner's own narration makes clear that he depended upon the USPS to forward Office correspondence to him after his move from his B Street offices to his Scranton Road offices—and, thus, he failed to Notice the Office in advance of his move as required. *See*: MPEP §601.03, which provides in pertinent part:

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). See 37 CFR §11.11 The notification should also include his or her telephone number.

As a result, the record evidences not that the Office ignored Petitioner's move or failed to incorporate into its records the data updates provided by Petitioner, but rather that Petitioner did not provide to the Office the data updates as required.

Moreover, Petitioner acknowledged that he knew on 28 March, 2008, that the application was deemed abandoned, but the record clearly shows that he took no action in this regard to obtain relief pursuant to 37 C.F.R. §1.181 until 10 July, 2008—more than three months later.

Clearly Petitioner ignored the express requirements of the rule as to seeking relief within two months of the act complained of.

Accordingly, Petitioner failed to satisfy the requirements set forth in the guidance in the Commentary at MPEP §711.03(c)(I)) to satisfy the mandated showings pursuant to 37 C.F.R. §1.181:

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record

would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.¹

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and those registered to practice and all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

¹ See: MPEP §711.03(c) (I)(A).

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Allegations as to the Request to
Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner appears not to have made the showing required.

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.181 is **dismissed**.

ALTERNATIVE VENUE

Should Petitioner wish to revive the application, Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See:

http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, a terminal disclaimer and fee where appropriate and a statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.” (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By facsimile: **(571) 273-8300**
 Attn: Office of Petitions

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,042	03/25/2002	Peter Brune	740-63	8011
7590 Lawrence A Maxham The Maxham Firm 750 B Street Suite 3100 San Diego, CA 92101		07/31/2007	EXAMINER CONTEE, JOY KIMBERLY	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/980,042	Applicant(s) BRUNE ET AL.	
	Examiner Joy K. Contee	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29 is/are allowed.
- 6) ☒ Claim(s) 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 30-31 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

2. Claims 1-29 are allowed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Fingerhut, US 6,418,129. Unimed Pharm Chem de Mexico

Regarding claim 30, Fingerhut discloses an arrangement for controlling installations and/or processes, comprising:

parts of an existing mobile communications network being used for the transmission of the respective data and arrangements are provided for the exchange of information between a dedicated network and elements of the mobile communication network which are participating in the information flow within the mobile communication network, with at least one coupling device being

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provided to permit an exchange of information between at least one location in the mobile communication network and a location in the dedicated network, wherein said coupling device has devices which can directly or indirectly select information elements from the information flow of the mobile communication network in a controlled manner that conforms to the protocol (col. 4, lines 46-66) or it can directly or indirectly insert information elements into the information flow of the mobile communication network in a controlled manner or it can replace corresponding elements of the information flow the mobile communication network (col. 5, line 20 to col. 6, line 53 and col. 9, line 64).

Regarding claim 31, Fingerhut discloses the arrangement according to claim 30, wherein as a coupling point of the mobile communication network to the dedicated in the mobile communication network, a unit is provided which has at least the function of a home location register and/or an authentication center (col. 5, lines 36-60).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K. Contee whose telephone number is 571.272.7906. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571.272.7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC

Joy Cortes
Patent Examiner